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EXAMINER

JACOBS, LASHONDA T

ART UNIT

PAPER NUMBER

2157

DATE MAILED: 08/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/641,495

Applicant(s)

BRISCOE ET AL.

Examiner

LaShonda T. Jacobs

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

This is a Final Office Action in response to Applicants' Amendment/Request for Reconsideration filed on May 9, 2005. Claim 24 has been amended. Claims 1-42 are presented for further examination.

Affidavits, Declarations

1. The affidavit filed on May 9, 2005 under 37 CFR 1.131 has been considered but is ineffective to overcome the Addante reference.
2. The affidavit was improperly executed. All applicants are required to sign the declaration as set forth below. A petition under 37 CFR 1.47 should have been filed along with the affidavit.
715.04 [R-2] Who May Make Affidavit or Declaration; Formal Requirements of Affidavits and Declarations

I. >< WHO MAY MAKE AFFIDAVIT OR DECLARATION

The following parties may make an affidavit or declaration under 37 CFR 1.131:

- (A) All the inventors of the subject matter claimed.
- (B) An affidavit or declaration by less than all named inventors of an application is accepted where it is shown that less than all named inventors of an application invented the subject matter of the claim or claims under rejection. For example, one of two joint inventors is accepted where

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it is shown that one of the joint inventors is the sole inventor of the claim or claims under rejection.

(C) **> If a petition under 37 CFR 1.47 was granted or the application was accepted under 37 CFR 1.42 or 1.43, the affidavit or declaration may be signed by the 37 CFR 1.47 applicant or the legal representative, where appropriate. <

(D) The assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor. *Ex parte Foster*, 1903 C.D. 213, 105 O.G. 261 (Comm'r Pat. 1903).

Affidavits or declarations to overcome a rejection of a claim or claims must be made by the inventor or inventors of the subject matter of the rejected claim(s), a party qualified under 37 CFR 1.42, 1.43, or 1.47, or the assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor(s). Thus, where all of the named inventors of a pending application are not inventors of every claim of the application, any affidavit under 37 CFR 1.131 could be signed by only the inventor(s) of the subject matter of the rejected claims. Further, where it is shown that a joint inventor is deceased, refuses to sign, or is otherwise unavailable, the signatures of the remaining joint inventors are sufficient. However, the affidavit or declaration, even though signed by fewer than all the joint inventors, must show completion of the invention by all of the joint inventors of the subject matter of the claim(s) under rejection. In *re Carlson*, 79 F.2d 900, 27 USPQ 400 (CCPA 1935).

3. What is meant by diligence is brought out in *Christie v. Seybold*, 1893 C.D. 515, 64 O.G. 1650 (6th Cir. 1893). In patent law, an inventor is either diligent at a given time or he is not diligent; there are no degrees of diligence. An applicant may be diligent within the meaning of

the patent law when he or she is doing nothing, if his or her lack of activity is excused. Note, however, that the record must set forth an explanation or excuse for the inactivity; the USPTO or courts will not speculate on possible explanations for delay or inactivity. See *In re Nelson*, 420 F.2d 1079, 164 USPQ 458 (CCPA 1970). Diligence must be judged on the basis of the particular facts in each case. See MPEP § 2138.06 for a detailed discussion of the diligence requirement for proving prior invention. Applicants have not provided any activity between May 5, 2000 and July 27, 2000 therefore there is lack of due diligence. The Remarks included the Declaration as to the dates of inactivity.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims **1-42** are rejected under 35 U.S.C. 103(a) as being unpatentable over Chlan et al (hereinafter, "Chlan" U.S. Pat. No. 6,385,642) in view of Addante.

As per claim **1**, Chlan discloses a system for obtaining enriched activity data in a client-server communications network wherein information requested by a network element is cached at one or more other network elements, comprising:

- a server network element including server software and a database for generating and storing a plurality of information files that are accessible to a requesting network

element, the information files including text files and key words that are interpreted by the requesting network element to display the information requested.

However, Chlan does not explicitly disclose:

- single pixel GIF request is transmitted from the requesting element over the communications network to the server network element which reads and stores enriched data contained therein.

Addante discloses method and apparatus for transaction tracking over a computer network including:

- single pixel GIF request is transmitted from the requesting element over the communications network to the server network element which reads and stores enriched data contained therein (paragraphs 0037-0038).

Given the teaching of Addante, it would have been obvious to one of ordinary skill in art at the time the invention was made to modify Chlan by including a tag to request for invisible GIFs in order to monitor or track transactions by a user in a timely and efficient manner.

As per claims 17 and 32, Chlan discloses a method and computer readable medium for obtaining enriched activity data in a client-server communications network wherein information requested by a network element is cached at one or more other network elements, comprising the acts of:

- generating and storing a plurality of information files at a server network element that are accessible to a requesting network element, the information files including text files and key words (col. 3, lines 33-67, col. 5, lines 65-67, col. 6, lines 1-16, lines 53-67, col. 7, lines 1-6, lines 35-58, col. 11, lines 32-45 and col. 12, lines 1-32); and

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- interpreting the information files including the text files and key words by the requesting network element to display the information requested (col. 3, lines 33-67, col. 5, lines 65-67, col. 6, lines 1-16, lines 53-67, col. 7, lines 1-6, lines 35-58, col. 11, lines 32-45 and col. 12, lines 1-32).

However, Chlan does not explicitly disclose:

- single pixel GIF request is transmitted from the requesting element over the communications network to the server network element which reads and stores enriched data contained therein

Addante discloses method and apparatus for transaction tracking over a computer network including:

- single pixel GIF request is transmitted from the requesting element over the communications network to the server network element which reads and stores enriched data contained therein (paragraphs 0037-0038).

Given the teaching of Addante, it would have been obvious to one of ordinary skill in art at the time the invention was made to modify Chlan by including a tag to request for invisible GIFs in order to monitor or track transactions by a user in a timely and efficient manner.

As per claims **2** and **18**, Chlan further discloses:

- one or more cache engines that are connected to at least one of the other network elements for temporarily storing requested information files that are served upon demand to the requesting network element (col. 3, lines 31-36 and col. 7, lines 1-16).

As per claims **3**, **19** and **33**, Chlan discloses the invention substantially as claims discussed above:

However, Chlan does not explicitly disclose:

- wherein the single pixel GIF request includes a Common Gateway Interface (CGI) query string appended to it that contains the enriched data.

Addante discloses method and apparatus for transaction tracking over a computer network including:

- wherein the single pixel GIF request includes a Common Gateway Interface (CGI) query string appended to it that contains the enriched data (paragraphs 0037-0038).

Given the teaching of Addante, it would have been obvious to one of ordinary skill in art at the time the invention was made to modify Chlan by including a tag to request for invisible GIFs in order to monitor or track transactions by a user in a timely and efficient manner.

As per claims **4**, **20** and **34**, Chlan discloses:

- wherein the CGI query string includes an identification of the location of the requested information file (col. 5, lines 18-40, col. 7, lines 1-16, lines 64-67 and col. 8, lines 1-11).

As per claims **5**, **21** and **35**, Chlan discloses:

- wherein the CGI query string includes a number of image objects contained in the information file (col. 5, lines 18-40, col. 7, lines 1-16, lines 64-67 and col. 8, lines 1-11).

As per claims **6**, **22** and **36**, Chlan discloses:

- wherein the CGI query string includes an identification of a network element that referred the requesting network element to the server network element (col. 5, lines 18-40, col. 7, lines 1-16, lines 64-67 and col. 8, lines 1-11).

As per claims **7, 23** and **37**, Chlan discloses:

- wherein the CGI query string includes a persistent cookie identification of the requesting network element (col. 7, lines 1-16).

As per claims **8** and **24**, Chlan discloses:

- wherein the client-server communications network is a global network such as the Internet (col. 3, lines 31-38).

As per claims **9, 25** and **38**, Chlan discloses:

- wherein the plurality of information files are hypertext documents written with HyperText Markup Language (HTML) tags (col. 5, lines 25-30).

As per claims **10** and **26**, Chlan discloses:

- wherein the hypertext documents contain source HTML code interpreted by the requesting element to generate the display of corresponding web pages stored at the server network element (col. 5, lines 25-40).

As per claim **11**, Chlan discloses:

- wherein the server network element is a HyperText Transfer Protocol (HTTP) server (col. 1, lines 63-67).

As per claims **12** and **28**, Chlan discloses:

- wherein the requesting network element is a client browser application (col. 5, lines 18-30).

As per claims **13, 29** and **40**, Chlan discloses the invention substantially as claims discussed above:

However, Chlan does not explicitly disclose:

- wherein the single pixel GIF request with an appended Common Gateway Interface (CGI) query string is included as part of a JavaScript command that is put directly into the HTML file.

Addante discloses method and apparatus for transaction tracking over a computer network including:

- wherein the single pixel GIF request with an appended Common Gateway Interface (CGI) query string is included as part of a JavaScript command that is put directly into the HTML file (paragraphs 0037-0038).

Given the teaching of Addante, it would have been obvious to one of ordinary skill in art at the time the invention was made to modify Chlan by including a tag to request for invisible GIFs in order to monitor or track transactions by a user in a timely and efficient manner.

As per claims **14, 30** and **41**, Chlan discloses:

- wherein the JavaScript command is a "document.write" command which places an expression that follows the command into a document window (col. 5, lines 25-40).

As per claims **15, 31** and **42**, Chlan discloses:

- wherein the expression contains a HyperText Markup Language (HTML) image (IMG) tag with a source (SRC) attribute that specifies the Uniform Resource Locator (URL) location for the hypertext document (col. 5, lines 25-40).

As per claim **16**, Chlan discloses:

- wherein the other network elements include any one or more of switch devices, router devices, gateways, and client computer devices (col. 3, lines 31-38).

As per claims **27** and **39**, Chlan discloses:

- wherein hypertext documents are stored at a HyperText Transfer Protocol (HTTP) server (col. 1, lines 63-67).

Response to Arguments

6. Applicant's arguments filed May 9, 2005 have been fully considered but they are not persuasive.

The Office notes the following arguments:

- a. The affidavit/declaration provided by the Applicants have been found ineffective.

In response to:

- a. The rejections of this Office Action still remains since the affidavit failed to overcome the Addante reference.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaShonda T. Jacobs whose telephone number is 571-272-4004. The examiner can normally be reached on 8:30 A.M.-5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on 571-272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LaShonda T Jacobs
Examiner
Art Unit 2157

ltj
July 27, 2005


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